

ESTTA Tracking number: **ESTTA602093**

Filing date: **05/02/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

|                                       |   |
|---------------------------------------|---|
| Name                                  | ClearOne  |
| Granted to Date of previous extension | 05/03/2014  |
| Address                               | 5225 Wiley Post Way, Suite 500<br>Salt Lake City, UT 84116<br>UNITED STATES |

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|----------------------------|--|
| Correspondence information | ClearOne<br>5225 Wiley Post Way, Suite 500<br>Salt Lake City, UT 84116<br>UNITED STATES<br>trademarks@parsonsbehle.com, mmcgann@parsonsbehle.com |
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### Applicant Information

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application No         | 85901105  | Publication date       | 03/04/2014 |
| Opposition Filing Date | 05/02/2014  | Opposition Period Ends | 05/03/2014 |
| Applicant              | Verident, LLC<br>27 Pemberton Lane<br>East Windsor, NJ 08520<br>UNITED STATES |                        |            |


### Goods/Services Affected by Opposition


|   |
|---|
| <p>Class 009. First Use: 2013/03/16 First Use In Commerce: 2013/03/16<br/>All goods and services in the class are opposed, namely: Computer application software for mobile phones, laptops and desktops, namely, software for transferring, transforming, distributing, and sharing data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content with other connected agents via networks, mobile devices, and other communications channels; Computer software and hardware for enabling real-time communication, collaboration, management and distribution of multimedia content, integration with web portals, distributed data and content management, document transformation, and content distribution; Computer software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Computer software for use in the encryption and decryption of digital files, including audio, video, text, binary, still images, graphics and multimedia files; Computer software that provides real-time, integrated business management intelligence by combining information from various databases and presenting it in an easy-to-understand user interface; Downloadable cloud computer software for use by a team to share and edit content; Downloadable computer software for use by a team to share and edit content; Enterprise software in the nature of a database for non-transactional data and a search engine for database content; Web site development software</p> |
| <p>Class 042. First Use: 2013/03/16 First Use In Commerce: 2013/03/16<br/>All goods and services in the class are opposed, namely: Providing on-line non-downloadable software for online real-time communication for work group collaboration</p>  |

## Grounds for Opposition


|                                      |                            |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

## Marks Cited by Opposer as Basis for Opposition

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3333223  | Application Date      | 08/08/2006 |
| Registration Date     | 11/13/2007   | Foreign Priority Date | NONE       |
| Word Mark             | CHAT   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 009. First use: First Use: 2006/04/07 First Use In Commerce: 2006/04/07 Electronic hardware accessories, namelyspeakers, speakerphones and micro-phonesand software that add two way audio conferencing capability to multiple devices |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 4276948  | Application Date      | 11/10/2011 |
| Registration Date     | 01/15/2013   | Foreign Priority Date | NONE       |
| Word Mark             | CHAT   |                       |            |
| Design Mark           |    |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 009. First use: First Use: 2012/01/09 First Use In Commerce: 2012/01/09 headsets for use with telephones and computers |                       |            |

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 4099658    | Application Date      | 04/27/2010 |
| Registration Date     | 02/14/2012 | Foreign Priority Date | NONE       |
| Word Mark             | CHATATTACH |                       |            |

|                     |  |
|---------------------|--|
| Design Mark         |    |
| Description of Mark | NONE   |
| Goods/Services      | Class 009. First use: First Use: 2010/09/17 First Use In Commerce: 2010/09/17 Electronic hardware accessories, namely, speakers, speakerphones and microphones, cables, firmware and software that add two way audio conferencing capability to multiple devices |

|             |  |
|-------------|--|
| Attachments | 76664333#TMSN.gif( bytes )<br>85469153#TMSN.jpeg( bytes )<br>85024105#TMSN.jpeg( bytes )<br>NoticeofOpposition.pdf(1904249 bytes ) |
|-------------|--|

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

|           |                    |
|-----------|--------------------|
| Signature | /Julie L. O'Tyson/ |
| Name      | Julie L. O'Tyson   |
| Date      | 05/02/2014         |

ClearOne, Inc.,  
Opposer,  
  
v.  
  
Verident , LLC, DBA Thinktastic Software,  
LLC,  
  
Applicant.

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Opposition No.: \_\_\_\_\_  
  
Serial No.: 85/901105  
  
Mark: CHATPOINT

Commissioner of Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

ClearOne, Inc., a Utah corporation, located and doing business at 5225 Wiley Post Way #500, Salt Lake City, UT 84116 (“Opposer”), believes that it will be damaged by registration of U.S. Trademark Application Serial No. 85/901105 (“Application”) for the word mark CHATPOINT, filed by Veridient, LLC, doing business as Thinktastic Software, LLC, located and doing business at 27 Pemberton Lane, East Windsor, NJ 08520 (“Applicant”), and therefore opposes the same.

1. By the Application, filed under Section 1(a) on April 12, 2013, Applicant seeks to obtain registration in International Class 009 on the Principal Register of the trademark CHATPOINT for:

4828-2165-6346.1

multimedia content with other connected agents via networks, mobile devices, and other communications channels; Computer software and hardware for enabling real-time communication, collaboration, management and distribution of multimedia content, integration with web portals, distributed data and content management, document transformation, and content distribution; Computer software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Computer software for use in the encryption and decryption of digital files, including audio, video, text, binary, still images, graphics and multimedia files; Computer software that provides real-time, integrated business management intelligence by combining information from various databases and presenting it in an easy-to-understand user interface; Downloadable cloud computer software for use by a team to share and edit content; Downloadable computer software for use by a team to share and edit content; Enterprise software in the nature of a database for non-transactional data and a search engine for database content; Web site development software.

2. Applicant also By seeks to obtain registration in International Class 042 on the Principal Register of the trademark CHATPOINT for: Providing on-line non-downloadable software for online real-time communication for work group collaboration.

3. ClearOne is the owner of the following registrations issued by the United States Patent and Trademark Office, as well as all of the business and goodwill represented thereby:

| Mark       | Serial No. | Reg. No.  | Date of Reg. | Goods  |
|------------|------------|-----------|--------------|--|
| CHAT       | 76/664333  | 3,333,223 | 11/13/2007   | ELECTRONIC HARDWARE ACCESSORIES, NAMELY SPEAKERS, SPEAKERPHONES AND MICROPHONES AND SOFTWARE THAT ADD TWO-WAY AUDIO CONFERENCING CAPABILITY TO MULTIPLE DEVICES                      |
| CHAT       | 85/469153  | 4,276,948 | 1/15/2013    | HEADSETS FOR USE WITH TELEPHONES AND COMPUTERS   |
| CHATATTACH | 85/024105  | 4,099,658 | 4/27/2010    | ELECTRONIC HARDWARE ACCESSORIES, NAMELY, SPEAKERS, SPEAKERPHONES AND MICROPHONES, CABLES, FIRMWARE AND SOFTWARE THAT ADD TWO WAY AUDIO CONFERENCING CAPABILITIES TO MULTIPLE DEVICES |

4. Registration Nos. 3,333,223; 4,276,948; and 4,099,658 (the “CHAT Marks”) are valid and subsisting, unrevoked and uncanceled.



5. Opposer owns and relies on above registrations, filed under Section 1(a) in International Class 09.

6. Since April of 2006, ClearOne has offered a line of personal conferencing equipment under the CHAT brand name; the CHAT and CHATATTACH products lines currently feature over ten products including headsets and portable audio peripherals that can be used with phones or other devices to deliver both audio conferencing and rich audio playback for music sound files, as well as more sophisticated conferencing systems that allow for conferencing in small, medium, or large conference rooms. By virtue of Opposer's long, continuous, exclusive and substantial use, the Opposer's mark has become an identifier of Opposer and its goods and services, and distinguishes Opposer's goods from the goods and services of others.

7. Opposer has priority of use by virtue of its common law rights as described above. Opposer relies on its common law trademark rights.

8. Applicant seeks an unrestricted federal registration for CHATPOINT covering the goods set forth in the Application in International Classes 009 and 042. Accordingly, if a registration issues for the Application, such registration will constitute *prima facie* evidence of the Applicant's exclusive right to use the registered mark in commerce on or in connection with the listed goods throughout the United States with no limitation thereon.

9. Opposer will be damaged by registration of the Application in that the CHATPOINT is highly similar in sound and meaning as Opposer's CHAT and CHATATTACH marks. Accordingly, when used on or in connection with the goods as they are identified in the Application, Applicant's CHATPOINT mark is likely to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Notably, both marks deal in highly related goods and services. This commonality poses a palpable threat to Opposer's CHAT and CHATATTACH marks.

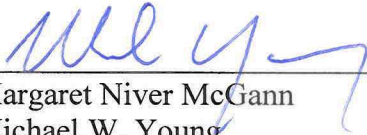
10. In view of Opposer's prior rights in its marks, Applicant is not entitled to federal registration of the CHATPOINT mark pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer prays that U.S. Trademark Application Serial No. 85/901105 be rejected and stricken, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

Parsons Behle & Latimer

Dated this 2nd day of May, 2014:

By:   
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Attorneys for Opposer,  
ClaerOne, Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant by depositing one copy thereof in the United States Mail, first-class postage prepaid, on May 2, 2014, addressed as follows:

Jeffrey Neu  
318 Newman Springs Road  
Red Bank, New Jersey

/s/ Julie O'Tyson \_\_\_\_\_  
Julie O'Tyson